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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/534,282    03/24/00    GUNSEL

S    42053.6USPT

EXAMINER

024238    IM52/0813  
JENKENS & GILCHRIST, A PROFESSIONAL CORP  
1100 LOUISIANA  
SUITE 1800  
HOUSTON TX 77002-5214

BERNATZ, K	
ART UNIT	PAPER NUMBER

1773  
DATE MAILED:

08/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/534,282	GUNSEL ET AL.	
	Examiner	Art Unit	
	Kevin M Bernatz	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>8</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>7</u> . | 6) <input type="checkbox"/> Other:   |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendments to the specification and claims 1 – 12, 14 – 26, 29, 30, 33 and 35, filed on June 12, 2001, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 1 – 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng ('216) in view of Venier and Casserly (Lubrication Engineering, 47(7), 1991, pgs 586 – 591) and further in view of Venier et al. ('023).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 15 of the Office Action mailed on March 12, 2001 (Paper No. 5).

### ***Response to Arguments***

4. **The objection of the specification**

This objection has been overcome via applicants' amendment.

5. **The objection of claim 11**

This objection has been overcome via applicants' amendment.

**6. The rejection of claim 1 under 35 U.S.C § 112 – 2<sup>nd</sup> Paragraph**

This rejection has been overcome via applicants' amendment.

**7. The rejection of claims 1 – 12 and 26 - 30 under 35 U.S.C § 102(b) – MATU**

Applicant(s) argue(s) that MATU does not anticipate the amended claims. The examiner agrees and this rejection has been withdrawn.

**8. The rejection of claims 1 - 31 under 35 U.S.C § 102(b) – Baum et al.**

Applicant(s) argue(s) that Baum et al. does not anticipate the amended claims. The examiner agrees and this rejection has been withdrawn.

**9. The rejection of claims 1 - 37 under 35 U.S.C § 103(a) – Ng in view of Venier and Casserly and further in view of Venier et al.**

Applicant(s) argue(s) that there is no teaching, suggestion or motivation to combine the teachings of Ng with those of Venier and Casserly and Venier et al. The examiner respectfully disagrees.

The examiner reminds applicants that it is not necessary that the references actually suggest, expressly or in so many words, the changes or improvements that the applicant has made. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. *In re Sheckler*, 168 USPQ 716 (CCPA 1971); *In re McLaughlin*, 170 USPQ 209 (CCPA 1971); *In re Young*, 159 USPQ 725 (CCPA 1968). In the instant case, Ng teaches a

Art Unit: 1773

magnetic recording medium comprising lubricants based on an unsaturated cyclic nucleus containing polar substituents for improved linking and bonding. Venier and Casserly and Venier et al. teach that hydrocarbyl-substituted cyclo(pentane, pentene and pentadiene) compounds provide improved lubricating properties versus conventional lubricants, see Paragraph 15 of the Office Action Mailed March 12, 2001 (Paper No. 5). As such, the examiner deems that Venier and Casserly and Venier et al. provide clear motivation to use hydrocarbyl-substituted cyclo(pentenenes or pentadienes) as the unsaturated cycloaliphatic nucleus of Ng since they are merely a species of the disclosed genus. While Ng teaches away from using non-fluorinated substituted cyclic compounds, the examiner notes that applicants' definition of "hydrocarbyl group" clearly encompasses fluorinated compounds (applicants' specification, page 7) and, therefor, fluorinated or non-fluorinated substituents are deemed to be art recognized equivalents barring a showing of criticality.

In addition, applicants are reminded that the test of obviousness is not express suggestion of the claimed invention in any or all references but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them. *In re Rosselet*, 347 F.2d 847, 146 USPQ 183 (CCPA 1965); *In re Hedges*, 783 F.2d 1038. In the instant case, the references relied upon in Paragraphs 15 and 16 of the Office Action mailed March 12, 2001 (Paper No. 5) teach and suggest functionalized hydrocarbyl-substituted cyclo(pentene and pentadiene) compounds that are obvious species of the substituted cyclic unsaturated compounds disclosed by Ng, and are therefor deemed equivalents barring a showing of criticality of

Art Unit: 1773

one moiety over another. Furthermore, Venier and Casserly, Venier et al., Ng, Hayashi ('983), Tsuchiya et al. ('516), Falcone ('169), and Yanagihara et al. ('799) all disclose teachings offering advantages to using functionalized groups meeting applicants' claimed limitations, especially polar hydrocarbyl groups, see Paragraphs 15 and 16 of the Office Action mailed March 12, 2001 (Paper No. 5).

As such, the examiner deems that it would have been obvious to use hydrocarbyl-substituted cyclo(pentene or pentadiene) as the unsaturated cyclic compounds of Ng and that the hydrocarbyl substituted cyclic compounds of Venier and Casserly and Venier et al. are merely a species of this genus and are therefor deemed equivalent barring a showing of criticality. Furthermore, several of the disclosed references teach the advantages of polar and other functional groups meeting applicants' claimed limitations with respect to lubricating compounds. Finally, applicants' claims are open to fluorinated compounds being encompassed by the term "hydrocarbyl", based on both the prior art and applicants' definition of the term.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 1773

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB  
August 9, 2001



STEVAN A. RESAN  
PRIMARY EXAMINER